



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
COMMERCIAL AND ADMINISTRATIVE CENTER
WASHINGTON, DC 20540
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONVENTION NO.
09/744,614	01/26/2001	John G. Carman	T9212 PCT US	1620

20450 0890 01/14/2002

ALAN J HOWARTH
PO BOX 1909
SANDY, UT 84097

EXAMINER

MOONAN, FRANCIS P

ARTICLE PAPER NUMBER

1638

DATE MAILED: 01/14/2002

Please find below and or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,614

Applicant(s)

CARMAN, JOHN G.

Examiner

Francis P Moonan

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a) in no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other

DETAILED ACTION

Claims 1-7 are restricted in the Office Action that follows.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I. Claims 1-2, and 5, drawn to a method of making a genetically stabilized polyploid apomictic plant by sexual hybridization.

Group II. Claims 1-2, drawn to a method of making a genetically stabilized polyploid apomictic plant by chemical treatment.

Group III. Claim 3, drawn to a method of making a genetically stabilized apomictic plant with chemical or irradiation induced mutagenesis.

Group IV. Claim 3, drawn to a method of making a genetically stabilized apomictic plant with application of stress to a plant.

Group V. Claim 4, 5, and 7 drawn to a method of making a genetically stabilized apomictic plant by transformation with a recombinant nucleic acid construct.

Group VI. Claim 6, drawn to a method of making a plant with a high frequency of sexual seed formation from an apomictic plant, by transforming said apomictic plant with a recombinant antisense nucleic acid construct.

Claims 1-3 and 5 will be examined to the extent that they read on the elected invention.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking Groups I-VI appears to be is that they are each a method of making a genetically stabilized apomictic plant. However, a method of making a genetically stabilized apomictic plant lacks an inventive step or is not novel in view of ELLERSTROM (1983, Hereditas 99:315). Therefore the technical feature linking the inventions of Groups I-VI does not constitute a special technical feature as defined by PCT Rule 13.2, because it does not define a contribution over the prior art.

The special technical feature of Group I is drawn to a first process that utilizes a mode of operation effected by sexual hybridization procedures between plants that result in the allopolyploidization of progeny, that is not required of the other Groups.

The special technical feature of Group II is that it is drawn to a second process that utilizes a mode of operation effected by chemical treatments of plants or plant parts that result in the autopolyploidization of plant cells, for example by chemical treatment with an agent such as colchicine, that is not required of the other Groups.

The special technical feature of Group III is that it is drawn to a third process that utilizes a mode of operation effected by procedures for mutagenesis of plants, for example procedures requiring alkylating chemical mutagenic compounds or procedures with ultraviolet or gamma-irradiation treatments, that is not required of the other Groups.

The special technical feature of Group IV is that it is a fourth process that utilizes a mode of operation effected by procedures requiring the application of stress to a plant, such as dehydration, freezing, or light intensity stress, that is not required of the other Groups.

The special technical feature of Group V is that it is drawn to a fifth process that utilizes a mode of operation effected by nucleic acid cloning and plant transformation procedures

Art Unit: 1638

requiring different methodologies and manipulation steps, such as the manipulation of biological transformations agents such as *Agrobacterium*, or the operation of an apparatus such as a particle gun apparatus, that is not required by the other Groups.

The special technical feature of Group VI is that it is drawn to a sixth process that is independent and distinct from the other Groups. Group VI is a method to alter the normal asexual reproductivity of an apomictic plant to that of a mode of sexual reproduction, while Groups I-V are methods to make apomictic plants from sexually reproducing plant germplasm. The method of Group VI is therefore a distinctly different invention from the methods of Groups I-IV, because the starting materials, method steps, and products made in Group VI are not required of Groups I-V, and the starting materials, method steps, and products made in Groups I-V are not required of Group VI.

Because these inventions are independent and distinct for the reasons stated above, the search for one group is not required of the others, and a search of all of the Groups would place an undue burden of search on the examiner, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1638

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis Moonan, whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday 9:00 AM to 5:00 PM (E.S.T.)

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4315. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Francis Moonan, Ph. D.
9 January 2002

1638
Francis Moonan